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Dkt. 0575/68548-PCT-US/JPW/JCS

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicants : Shi Du Yan, et al.  
U.S. Serial No.: 10/577,382  
Filed : April 27, 2006  
For : Methods for Reducing Seizure-Induced Neuronal Damage

1185 Avenue of the Americas  
New York, New York 10036  
February 7, 2008

Mail Stop Petition  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

**PETITION TO REVIVE AN UNINTENTIONALLY  
ABANDONED APPLICATION UNDER 37 C.F.R. §1.137(b)**

This Petition is submitted to revive the above-identified application under 37 C.F.R. §1.137(b).

**Requirements of Petition to Revive**

A petition under 37 C.F.R. §1.137(b) must be accompanied by:

- (1) the required reply, unless it has been previously filed;
- (2) the petition fee set forth in 37 C.F.R. §1.17(m);
- (3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional; and
- (4) any terminal disclaimer (and fee set forth in §120(d)) required pursuant to 37 C.F.R. §1.137(d) for a utility

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application filed before June 8, 1995.

**Required Reply Under 37 C.F.R. §1.137(b)(1)**

A Notice of Defective Response was issued on September 4, 2007 indicating that the declaration submitted with applicants' April 9, 2007 Communication in Response to January 8, 2007 Notification of Missing Requirements Under 35 U.S.C. §371 in the United States Designated/Elected Office does not comply with 37 C.F.R. §1.497(a). Specifically, the Notice indicated that the declaration appeared to be a compilation of a number of separate declaration documents, which must be submitted as individual declarations, rather than combined into one declaration.

Applicants filed a Communication in Response to September 4, 2007 Notice of Defective Response on October 4, 2007 resubmitting a copy of the previously filed declaration and explaining why the declaration as filed was in compliance with 37 C.F.R. §1.497(a).

However, the U.S. Patent Office disagreed with applicants' position and issued a Decision on Petition under 37 C.F.R. §1.181 on December 7, 2007 declaring that the subject application had been abandoned. A copy of the Decision is attached as **Exhibit 1** hereto.

In response, applicants maintain that the signed Declaration and Power of Attorney submitted with their April 9, 2007 Communication in Response to January 8, 2007 Notification of Missing Requirements Under 35 U.S.C. §371 in the United States Designated/Elected Office and also with their October 4, 2007 Communication in Response to September 4, 2007 Notice of Defective Response is in compliance

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with 37 C.F.R. §1.497(a) and (b), and respectfully maintain their disagreement with the Patent Office's interpretation of 37 C.F.R. §1.497(a) and (b) and M.P.E.P 201.03(II)(B)<sup>1</sup>.

However, in order to insure that this case is not abandoned, applicants attach three separate Declarations and Power of Attorneys, one signed by each of Shi Du Yan, Guy McKhann, and David M. Stern, and attached hereto as **Exhibits A, B, and C**, respectively. Accordingly, the required reply is being submitted.

**Petition Fee Required Under 37 C.F.R. §1.137(b)(2)**

The required fee for filing a Petition under 37 C.F.R. §1.137(b) as set forth in 37 C.F.R. §1.17(m) is \$1,540.00. A check in the amount of \$1,540.00 is enclosed herewith.

**Statement that the Entire Delay in Filing the Required Reply was Unintentional Under 37 C.F.R. §1.137(b)(3)**

The entire delay in filing the required reply was unintentional as evidenced by applicants' two previous submissions of declarations signed by the inventors.

**Terminal Disclaimer Under 37 C.F.R. §1.137(b)(4)**

Because the subject application was filed on October 28, 2004, i.e., after June 8, 1995, no terminal disclaimer need be filed.

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<sup>1</sup>Applicants request that the Office reconsider its position and refund the enclosed Petition fee. Applicants are also considering what further action would be appropriate to challenge the Office's position.

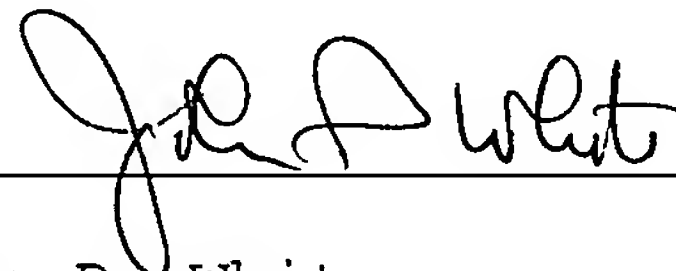
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In view of the attached three separate declarations and power of attorneys and the preceding remarks, applicants earnestly solicit an expeditious revival of the subject application.

If a telephone interview would be of assistance in resolving any issue in connection with this petition, applicants' undersigned attorney invites the appropriate representative of the Office to telephone him at the number provided below.

No fee, other than the enclosed \$1,540.00 petition fee under 37 C.F.R. §1.17(m), is deemed necessary in connection with the filing of this Petition. However, if any additional fee is required, authorization is hereby given to charge the amount of any such fee to Deposit Account No. 03-3125.

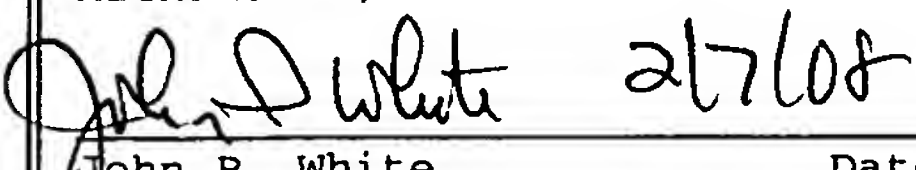
Respectfully submitted,



John P. White  
Registration No. 28,678  
Attorney for Applicants  
Cooper & Dunham LLP  
1185 Avenue of the Americas  
New York, New York 10036  
(212) 278-0400

I hereby certify that this correspondence is being deposited this date with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed to:

Mail Stop Petition  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

  
John P. White  
Reg. No. 28,678

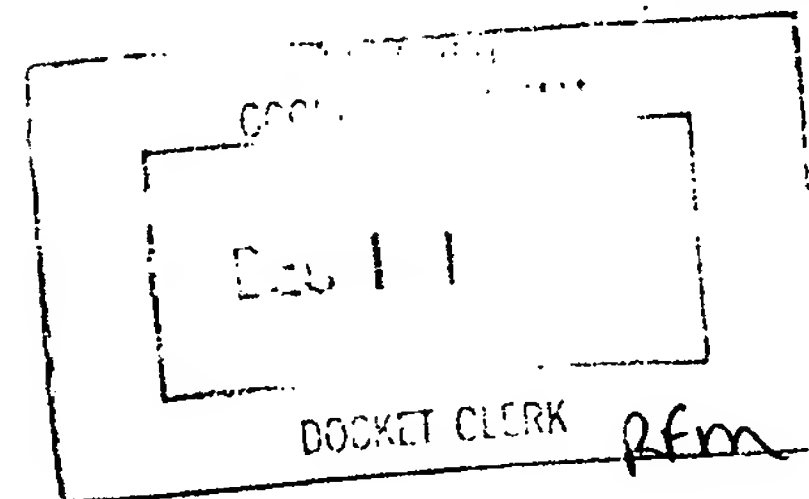
Date

**EXHIBIT 1**



07 DEC 2007

Cooper & Dunham, LLP  
1185 Avenue of the Americas  
New York, New York 10036



In re Application of:  
YAN et al.  
U.S. Application No.: 10/577,382  
PCT No.: PCT/US04/36173  
International Filing Date: 28 October 2004  
Priority Date: 31 October 2003  
Attorney's Docket No.: 68548-PCT-US/JPW/JW  
For: METHODS FOR REDUCING  
SEIZURE-INDUCED NEURONAL  
DAMAGE

DECISION ON PETITION  
UNDER 37 CFR 1.181

Petition to Revoke Due 2-1-07  
Reminder

This decision is issued in response to the "Communication in Response To September 4, 2007 Notification Of Defective Response" filed 09 October 2007, which is being treated as a request to accept the declaration filed 12 April 2007 under 37 CFR 1.181. No petition fee is required.

**BACKGROUND**

On 28 October 2004, applicants filed international application PCT/US04/36173 which claimed a priority date of 31 October 2003 and which designated the United States. The deadline for submitting the basic national fee was thirty months from the priority date, i.e., 01 May 2006.

On 27 April 2006, applicants filed a transmittal letter for entry into the national stage in the United States accompanied by, among other materials, payment of the basic national fee.

On 08 January 2007, the United States Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497 was required. Furthermore, the Notification indicated that a Sequence Listing had not been filed as required by 37 CFR 1.821(c) and (e).

On 12 April 2007, applicants filed a "Communication in Response to January 8, 2007 Notification of Missing Requirements under 35 U.S.C. 371 in the United States Designated/Elected Office and Petition for a One-Month Extension of Time" which included five pages of declaration materials and a statement that "the subject application does not contain any nucleotide or amino acid sequences as defined in 37 CFR 1.821."

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U.S. Serial No. 10/577,382  
Filed: April 27, 2006  
Exhibit 1

On 04 September 2007, the DO/EO/US mailed a Notification Of Defective Response (Form PCT/DO/EO/916) indicating that the filed declaration was defective because "the declaration document appears to be a compilation of a number of separate declaration documents." The Notification indicated that the failure to file a proper response within one month would result in abandonment of the application.

On 09 October 2007, applicants filed the Response considered herein. The response was not accompanied by a revised oath or declaration. Rather, the response consists of an argument by applicants that the previously filed declaration was in an acceptable form.

### DISCUSSION

In applicants' response to the Notification Of Defective Response, counsel asserts that the five pages filed 12 April 2007 were a single document and that the declaration therefore satisfies the requirements of 37 CFR 1.497. However, a review of the filed declaration materials contradicts the assertion that the document is a single, five-page declaration.

The filed declaration materials consist of:

- (1) a first page, identified as "Declaration and Power of Attorney," that identifies the application and sets forth the priority claim under 35 U.S.C. 119(a)-(d);
- (2) a page, identified as "Page 2" that identifies the application and sets forth the priority claim under 35 U.S.C. 119(e);
- (3) a page, identified as "Page 3" which is executed by Shi Du YAN. This page identifies Shi Du YAN as the first inventor, Guy MCKHANN as the second inventor, and David STERN as the third inventor;
- (4) another page, identified as "Page 3" which is executed by Guy MCKHANN. This page identifies Shi Du YAN as the first inventor, Guy MCKHANN as the second inventor, and David STERN as the third inventor; and
- (5) another page, identified as "Page 3" which is executed by David STERN. This page identifies Shi Du YAN as the first inventor, Guy MCKHANN as the second inventor, and David STERN as the third inventor.

Thus, the five page submission consists of Page 1, Page 2, and three signature pages identified as "Page 3." Counsel avers that "each inventor was given a copy of the same declaration containing a complete listing of all inventors for his or her signature." Based on the above statement, it appears that counsel subsequently compiled the declaration into a single document, which is improper. Under these circumstances, the five pages of declaration materials filed 12 April 2007 cannot be treated as a single document. In addition, these materials cannot be accepted as a compilation of separate, complete declaration documents (see MPEP § 201.03, page 200-7: "Where individual declarations are



executed, they must be submitted as individual declarations rather than combined into one declaration"). Accordingly, the declaration filed 08 January 2003 remains unacceptable under 37 CFR 1.497.

Because applicants failed to submit a proper response to the Notification Of A Defective Response, this application became abandoned as of midnight on 04 September 2007.

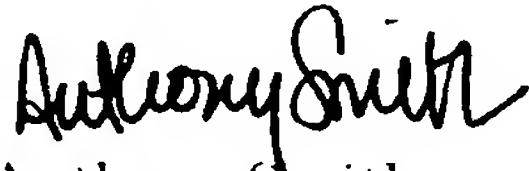
### **CONCLUSION**

Applicants request is **REFUSED** and this application is **ABANDONED**.

The application materials filed by applicant cannot be considered as a single document and such materials do not constitute an acceptable declaration in compliance with 37 CFR 1.497.

Applicants have failed to file a proper response to the Notification Of A Defective Response mailed 04 September 2007.

The application is being forwarded to the National Stage Processing Branch of the Office Of PCT Operations for further processing in accord with this decision, specifically, the issuance of a Notification Of Abandonment (Form PCT/DO/EO/909).



Anthony Smith  
Attorney-Advisor  
Office PCT Legal Administration  
Tel.: 571-272-3298  
Facsimile: 571-273-0459



**EXHIBIT A**

**DECLARATION AND POWER OF ATTORNEY**

*As a below-named inventor, I hereby declare that:*

*My residence, post office address, and citizenship are as stated below next to my name.*

*I believe I am the original, first and sole inventor (if only one name is listed below) or an original, first and joint inventor (if plural names are listed below) of the subject matter which is claimed and for which a patent is sought on the invention entitled:*

**METHODS FOR REDUCING SEIZURE-INDUCED NEURONAL DAMAGE**

*the specification of which:  
(check one)*

\_\_\_\_\_ *is attached hereto.*

X *was filed as §371 national stage of PCT/US2004/036173, filed*  
October 28, 2004 *as*

*Application Serial No.* 10/577,382

*and was amended on* April 27, 2006  
*(if applicable)*

*I hereby state that I have reviewed and understand the contents of the above-identified specification, including the claims, as amended by any amendment referred to above.*

*I acknowledge the duty to disclose to the U.S. Patent and Trademark Office all information known to me to be material to patentability as defined in Title 37, Code of Federal Regulations, Section 1.56.*

*I hereby claim foreign priority benefits under Title 35, United States Code, Section 119(a)-(d) or Section 365(b) of any foreign application(s) for patent or inventor's certificate, or Section 365(a) of any PCT International Application which designated at least one country other than the United States, listed below. I have also identified below any foreign application for patent or inventor's certificate, or PCT International Application having a filing date before that of the earliest application from which priority is claimed:*

*Prior Foreign Application(s)*

*Priority Claimed*

<u>Number</u>	<u>Country</u>	<u>Filing Date</u>	<u>Yes</u>	<u>No</u>
<u>PCT/US2004/036173</u>	<u>PCT</u>	<u>October 28, 2004</u>	<u>X</u>	_____
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*I hereby claim the benefit under Title 35, United States Code, Section 119(e) of any United States provisional application(s) listed below:*

<u>Provisional Application No.</u>	<u>Filing Date</u>	<u>Status</u>
60/516,323	October 31, 2003	Pending as of October 31, 2004

*I hereby claim the benefits under Title 35, United States Code, Section 120 of any United States Application(s), or Section 365(c) of any PCT International Application(s) designating the United States listed below. Insofar as this application discloses and claims subject matter in addition to that disclosed in any such prior Application in the manner provided by the first paragraph of Title 35, United States Code, Section 112, I acknowledge the duty to disclose to the United States Patent and Trademark Office all information known to me to be material to patentability as defined in Title 37, Code of Federal Regulations, Section 1.56, which became available between the filing date(s) of such prior Application(s) and the national or PCT international filing date of this application:*

<u>Application Serial No.</u>	<u>Filing Date</u>	<u>Status</u>
<u>PCT/US2004/036173</u>	<u>October 28, 2004</u>	<u>Pending as of April 30, 2006</u>
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*And I hereby appoint*

**John P. White (Reg. No. 28,678); Christopher C. Dunham (Reg. No. 22,031); Norman H. Zivin (Reg. No. 25,385); William E. Pelton (Reg. No. 25,702); Robert D. Katz (Reg. No. 30,141); Peter J. Phillips (Reg. No. 29,691); Paul Teng (Reg. No. 40,837); Alan J. Morrison (Reg. No. 37,399); Gary J. Gershik (Reg. No. 39,992);**

*and each of them, all c/o Cooper & Dunham LLP, 1185 Avenue of the Americas, New York, New York 10036, my attorneys, each with full power of substitution and revocation, to prosecute this application, to make alterations and amendments therein, to receive the patent, to transact all business in the Patent and Trademark Office connected therewith and to file any International Applications which are based thereon under the provisions of the Patent Cooperation Treaty.*

## Declaration and Power of Attorney

Page 3

Please address all communications, and direct all telephone calls, regarding this application to:

John P. White, Esq. Reg. No. 28,678  
Cooper & Dunham, LLP (Customer Number 23432)  
1185 Avenue of the Americas  
New York, New York 10036  
Tel. (212) 278-0400

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patents issued thereon.

Full name of sole or  
first joint inventor Shi Da Yan  
Inventor's signature [Signature] Date of signature 3/21/2007  
Citizenship United States of America  
Residence 58 Hamilton Place Tenafly, New Jersey 07670, United States of America  
Post Office Address see residence address

Full name of  
additional joint inventor (if any) Guy McKham  
Inventor's signature \_\_\_\_\_ Date of signature \_\_\_\_\_  
Citizenship United States of America  
Residence 5 Hilltop Road, Bronxville, New York 10708, United States of America  
Post Office Address see residence address

Full name of sole or  
first joint inventor David M. Stem  
Inventor's signature \_\_\_\_\_ Date of signature \_\_\_\_\_  
Citizenship United States of America  
Residence 8460 Springvalley Drive, Cincinnati, OH 45236  
Post Office Address see residence address

**EXHIBIT B**

**DECLARATION AND POWER OF ATTORNEY**

*As a below-named inventor, I hereby declare that:*

*My residence, post office address, and citizenship are as stated below next to my name.*

*I believe I am the original, first and sole inventor (if only one name is listed below) or an original, first and joint inventor (if plural names are listed below) of the subject matter which is claimed and for which a patent is sought on the invention entitled:*

**METHODS FOR REDUCING SEIZURE-INDUCED NEURONAL DAMAGE**

*the specification of which:  
(check one)*

       *is attached hereto.*

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*Application Serial No.* 10/577,382

*and was amended on* April 27, 2006  
*(if applicable)*

*I hereby state that I have reviewed and understand the contents of the above-identified specification, including the claims, as amended by any amendment referred to above.*

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<i>Prior Foreign Application(s)</i>			<i>Priority Claimed</i>	
<u>Number</u>	<u>Country</u>	<u>Filing Date</u>	<u>Yes</u>	<u>No</u>
<u>PCT/US2004/036173</u>	<u>PCT</u>	<u>October 28, 2004</u>	<u>X</u>	<u>      </u>
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**Applicants: Shi Du Yan, et al.**  
**Serial No. : 10/577,382**  
**Filed: April 27, 2006**  
**Exhibit B**

*I hereby claim the benefit under Title 35, United States Code, Section 119(e) of any United States provisional application(s) listed below:*

<u>Provisional Application No.</u>	<u>Filing Date</u>	<u>Status</u>
<u>60/516,323</u>	<u>October 31, 2003</u>	<u>Pending as of October 31, 2004</u>
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<u>Application Serial No.</u>	<u>Filing Date</u>	<u>Status</u>
<u>PCT/US2004/036173</u>	<u>October 28, 2004</u>	<u>Pending as of April 30, 2006</u>
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<u> </u>	<u> </u>	<u> </u>

*And I hereby appoint*

John P. White (Reg. No. 28,678); Christopher C. Dunham (Reg. No. 22,031); Norman H. Zivin (Reg. No. 25,385); William E. Pelton (Reg. No. 25,702); Robert D. Katz (Reg. No. 30,141); Peter J. Phillips (Reg. No. 29,691); Paul Teng (Reg. No. 40,837); Alan J. Morrison (Reg. No. 37,399); Gary J. Gershik (Reg. No. 39,992);

*and each of them, all c/o Cooper & Dunham LLP, 1185 Avenue of the Americas, New York, New York 10036, my attorneys, each with full power of substitution and revocation, to prosecute this application, to make alterations and amendments therein, to receive the patent, to transact all business in the Patent and Trademark Office connected therewith and to file any International Applications which are based thereon under the provisions of the Patent Cooperation Treaty.*



## Declaration and Power of Attorney

Page 3

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John P. White, Esq. Reg. No. 28,678  
Cooper & Dunham, LLP (Customer Number 23432)  
1185 Avenue of the Americas  
New York, New York 10036  
Tel. (212) 278-0400

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Full name of sole or  
first joint inventor

Shi Du Yan

Inventor's signature

Date of signature

Citizenship

United States of America

Residence

58 Hamilton Place, Tenafly, New Jersey 07670, United States of America

Post Office Address

see residence address

Full name of  
additional joint inventor(if any)

Guy McKhann

Inventor's signature

Date of signature

3/25/07

Citizenship

United States of America

Residence

5 Hilltop Road, Bronxville, New York 10708, United States of America

Post Office Address

see residence address

Full name of sole or  
first joint inventor

David M. Stern

Inventor's signature

Date of signature

Citizenship

United States of America

Residence

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Post Office Address

see residence address